

Remarks

In response to the Office Action mailed February 24, 2009, claims 33, 34, and 35 are hereby amended. No new matter is added. Support for the amendments to the claims is found in the as-filed Specification, *inter alia*, at paragraph 009, 015, 069, and in the figures. Upon entry of this amendment and response, claims 33-40 are pending.

Rejection Under 35 U.S.C. 102(b)

The Examiner rejected claims 33, 34, and 36-39 under 35 U.S.C. 102(b) as anticipated by Cheeseman (US 5,302,509). In response, Applicants have amended the claims to clarify that the added nucleotide has a free 3' hydroxyl at the time it is being added to the growing duplex. As noted by the Examiner, Cheeseman reports a fluorescently-labeled 3'-blocked nucleotide for addition to the growing strand. As a result of this clarifying language, Applicants respectfully submit that the claims are not anticipated by Cheeseman. Accordingly, Applicants request that the rejection be withdrawn.

Rejection Under 35 U.S.C. 103(a)

Claims 35 and 40 were rejected under 35 U.S.C. 103 as being obvious over Cheeseman in view of Jones (US 5,858,671). As noted above, Cheeseman only discloses 3'-blocked nucleotides for incorporation so as to allow single base duplex addition. As such, Cheeseman is missing an element of the present claims (e.g., a nucleotide for addition that has a free 3' hydroxyl at the time of addition). Jones fails to provide that missing element. Accordingly, Applicants respectfully submit that a prima facie case for obviousness has not been made. Because neither Cheeseman nor Jones provides all the elements of the present claims, either alone or in combination, Applicants respectfully submit that the rejection under 35 U.S.C. 103 should be withdrawn.

Summary

On the basis of the foregoing amendments and reasons, Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested.

If there are any questions regarding these remarks, the Examiner is invited and encouraged to contact Applicants' representative.

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